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rejection is overcome by claim 8, added hereby, which represents claim 6 having deleted, therefrom, at lines 1-2, the phrase "having two epoxy groups."

Claims were rejected under 35 U.S.C. §102(e) based on U.S. Pat. No. 5,968,681 (Miura).
Reconsideration is requested.

Miura represents an alleged anticipation of the claims. Thus, each and every claim limitation, as arranged in each of the rejected claims, must be found in Miura. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). Thus, each of the elements defining the "polyether copolymer," in each of the rejected claims, must be found in Miura or there is no anticipation under §102(e). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

According to the statement of rejection, each of the elements defining the "polyether copolymer" of present claim 1 is one of the reactants copolymerized to form the "polyepoxide" reaction product described in Miura. As such, the rejection relies on identifying the reactant "monomer of the formula (I)," in Miura, as the "repeating unit derived from propylene oxide," recited in present claim 1.

In accordance with the Miura (column 3, lines 44-48), the repeating unit having the formula "(I)" in the "polyepoxide" product is derived from the reactant "monomer of formula (I)" disclosed in the reference (which, allegedly, meets the "repeating unit derived from propylene oxide" recited in present claim 1. In accordance with the present specification, the formula "(I)" (found at page 3, lines 12-14) represents the "repeating unit derived from propylene oxide" recited in present claim 1.

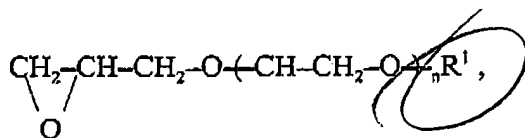
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The formula "(I)," representing the "repeating unit derived from propylene oxide" recited in present claim 1, is not the same as the repeating unit having the formula "(I)" in the "polyepoxide" product of Miura.

Applicants submit that none of the present claims is anticipated by Miura.

Miura discloses a polyether copolymer, which has repeating PO (propylene oxide) units derived from a monomer of the formula "(I)", i.e.,



which repeating units constitute a *side chain* of the polyether copolymer. In contrast, the "repeating unit derived from propylene oxide" constitutes the *main chain*, i.e., backbone, of the presently claimed "polyether copolymer."

Applicants submit that the backbone constituting the "repeating unit derived from propylene oxide" is a readily apparent feature of the presently claimed invention. Claim 1 contains the limitation "3 to 30 by mol of repeating unit derived from propylene oxide" (in the "polyether copolymer"). If the propylene oxide unit were in a side chain of the "polyether copolymer," claim 1 could not contain such a limitation.

Moreover, attention is directed to the passages at page 4, lines 21-23, of the present specification. This passages states:

Specifically, the polyether copolymer of the present invention can be obtained by reacting (A) propylene oxide, (B) ethylene oxide and (C) the crosslinkably reactive monomer with each other

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This quoted text describes a crosslinking reaction, by which is produced a polyether copolymer having a backbone made up of repeating units derived from propylene oxide.

As opposed to the presently claimed invention, "3 to 30 by mol of repeating unit derived from propylene oxide" is not a feature (i.e., limitation) of the polyether copolymer described in Minura. This is because, as explained above, the claim limitation requires that the repeating units derived from propylene oxide constitute the backbone of the polyether, whereas, the repeating units of propylene oxide in Minura constitute a side chain of the polyether copolymer. Since a limitation in the present claims is not found in Miura, anticipation is negated. *Kolster Speedsteel A B, supra*. Accordingly, the rejection under 35 USC 102(e) based on Minura cannot be maintained.

Claims were rejected for alleged obviousness-type double patenting based on Miura. Reconsideration is requested.

Evaluating a claim for obviousness-type double patenting with respect to a claim or claims in a patent requires a two-step analysis. First, differences in subject matter between the application claim and the patent claim or claims are determined. Secondly, a determination is made as to whether the differences in subject matter between application claims, on the one hand, and patent claims, on the other, are patentably distinct differences.

First of all, the statement of rejection does not identify all of the differences between the present claims and the patented claims. The statement of rejection alleges that the only differences between the application claims and the claims of Miura are the weight percentages recited for each of the monomers in the instant claims. As explained above, "3 to 30 by mol of repeating unit

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derived from propylene oxide" is not a feature (i.e., limitation) of the polyether copolymer described in Miura. Thus, the rejection for obviousness-type double patenting based on Miura cannot be maintained.

Secondly, the statement of rejection relies on the argument that differences between the application claims and the claims of Miura are *per se* obvious optimization of weight percentages recited for each of the monomers in the instant claims. The statement of rejection provides neither evidence nor scientific reasoning that explains how the skilled artisan would have considered it obvious to optimize the amounts described in Miura in order to arrive at the weight percentages recited in the present claims.

The rejection cannot rely on the argument of obvious to optimize amounts, as this is a proscribed *per se* basis for rejection. "Reliance on *per se* rules of obviousness is legally incorrect and must cease." *In re Ochai*, 37 USPQ2d 1127, 1129 (Fed. Cir. 1995). That a difference with the prior art amounts to an alleged "optimal condition . . . is not a substitute for some teaching or suggestion supporting an obviousness rejection." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Where the *optimization* of a claim variable was not recognized in the art as effecting the claimed result, the result is unobvious. *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977). Whether the difference with the application claims amounts to a large or small modification is irrelevant, because "a 'little modification' can be a most unobvious one. *In re Irani*, 166 USPQ 24, 27 (CCPA 1970).

Since the statement of rejection fails to provide the requisite factual basis to support the rejection for obviousness type double patenting, the rejection cannot be maintained.

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Favorable action is requested.

Respectfully submitted,

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